

IN THE UNITED STATES PATENT AND TRADEMARK OFFICEIN RE APPLICATION OF: Harley *et al.*

SERIAL NO.: 10/562,374

I.A. FILING DATE: 06/23/2004

FOR: COMPOSITIONS AND METHODS FOR
INCREASING TELOMERASE ACTIVITY

EXAMINER: unassigned

ART UNIT: unassigned

CONF. NO.: 7952

Petition under 37 CFR §1.47(a)

Applicants hereby petition, under 37 CFR §1.47(a), to make the present application on behalf of themselves and the nonsigning inventor, David M. Miller-Martini, who has refused to join in the application. Provided herein, in accordance with this section, are proof of the pertinent facts, the last known address of the nonsigning inventor, and the petition fee of \$200.00.

Statement of Facts

I, the undersigned, am the agent of record in the above-referenced application. The following describes, to the best of my knowledge, the facts relied on to establish that Dr. David M. Miller-Martini has refused to sign the application papers (Declaration of Inventorship) in this application.

Dr. Miller-Martini is one of six co-inventors of the subject application.

Dr. Miller-Martini was an employee of Hong Kong University of Science and Technology (HKUST) when he worked on the subject invention, and in accordance with the requirements of his conditions of employment, and Hong Kong law, assigned to HKUST the entire right, title and interest in the inventions set forth in provisional application USSN 60/480,988, to which the above-referenced application claims priority, and any patents "granted thereon and therefor". The assignment, attached hereto as Exhibit A, was executed by Dr. Miller-Martini on October 9, 2003.

Dr. Miller-Martini subsequently left his employment at HKUST. His most recent known address is 409 Pine St., Ridgway PA 15853.

The Notice to File Missing Parts in the above-referenced application was received in the offices of Perkins Coie, LLP on May 15, 2006. Documents to be signed by each inventor, including the Declaration of Inventorship, were prepared at Perkins Coie and sent to Geron Corporation, assignee of the application, on June 9, 2006. A copy of Perkins Coie's cover letter is enclosed as Exhibit B.

The documents were then forwarded by Geron to Mr. Tony Eastham, President and CEO of HKUST, for presenting to the inventors. A copy of Geron's cover letter is enclosed as Exhibit C. Note that the letter emphasizes that the inventor is to sign the Declaration only after having read a copy of the subject application.

On July 11, 2006, I received an email (Exhibit D) from a Ms. Kathleen Geubelle, addressed to me and copied to Dr. Miller-Martini. The email stated that Dr. Miller-Martini had "several concerns" regarding the applications (the above-referenced application and two copending applications) and more specifically stated that "his three concerns pertain to an incorrect reference to his citizenship, current address, and order of inventors listed in the applications". I was asked to contact Dr. Miller-Martini's legal counsel, Mr. David Pontzer, regarding these matters.

(This email refers to the applications that Dr. Miller-Martini "received from HKUST", further establishing that the inventor was presented with a copy of the subject application.)

I subsequently left a message with Mr. Pontzer as instructed, but I did not receive a reply. On August 14, 2006, I sent a reply email (Exhibit E) to Ms. Geubelle, copying Dr. Miller-Martini and Dr. David Earp, chief patent counsel at Geron Corporation. In this email I pointed out that the concerns stated above should not be very difficult to resolve.

On August 17, 2006, Dr. Miller-Martini sent a reply email (Exhibit F) addressed to me and copied to Dr. Earp and Dr. Miller-Martini's legal counsel. Dr. Miller-Martini declined to execute the Declaration of Inventorship, stating that "execution of these documents will only occur 'subsequent' to your client [Geron Corp.] and their joint venture partner [HKUST] having obtained an appropriate license to my rights and interests in these drug molecules/fractions/formulations." A later email (Exhibit G) from Dr. Miller-Martini similarly stated that he would execute the documents if "in so doing I do not forfeit my rights and interests in these inventions".

Dr. Miller-Martini's contention that he retains "rights and interests in these inventions" is consistent with the position taken in his letter to the Chairman of HKUST, dated June 16, 2006 (Exhibit H). In that letter he not only asserted these rights and interests but also suggested that he would disclose claimed subject matter (and other confidential information) to "third party competitors" if no license were negotiated between himself and HKUST.

In view of the above, (1) Dr. Miller-Martini has assigned any rights he had in this application to his former employer, HKUST (see assignment, Exhibit A), in accordance with his legal obligations; and (2) Dr. Miller-Martini's stated conditions for executing the application papers (requiring HKUST to negotiate a license) constitute a refusal to execute the application papers.

Conclusion

The applicants submit that this petition complies with the requirements of 37 CFR §1.47(a) and MPEP §409.03(d), and gives documented evidence that the application papers were duly presented to the inventor, and that the inventor refused to sign the application papers.

Respectfully submitted,



LeeAnn Gorthey
Registration No. 37,337

Date: Sept. 5, 2006

Correspondence Address:

PAYOR NUMBER 22918

Telephone: (503) 727-2116

ASSIGNMENT

Whereas we, NancyYuk-yu Ip, Yung-hou Wong, David M. Miller-Martini

executed employment agreements with Hong Kong University of Science and Technology (hereinafter called HKUST), a tertiary educational Institution having its principal place of business at Clear Water Bay, Kowloon, Hong Kong, whereby we have agreed to assign to HKUST all inventions (except as otherwise limited by law) which relate to HKUST business and which were first conceived or actually reduced to practice during our employment by HKUST;

Now, therefor, pursuant to the terms of said employment agreements and for good and valuable consideration, receipt of which is hereby acknowledged, we do hereby sell, assign and transfer unto HKUST, its successors and assigns, the entire right, title and interest, including the right of priority in, to and under an application for Letters Patent of the United States entitled:

COMPOSITIONS AND METHODS FOR INCREASING TELOMERASE ACTIVITY

Serial No. 60/480,988 filed on 23 June 2003 and the inventions set forth and described therein, and any and all Letters Patent of the United States and of countries foreign thereto which may be granted thereon or therefor;

And for the above consideration, we agree promptly upon request of HKUST, its successors or assigns, to execute and deliver without further compensation any power of attorney, assignment, application, whether original, continuation, divisional or reissue, or other papers which may be necessary or desirable fully to secure to HKUST, its successors and assigns, the inventions described in said application and all patent rights therein, in the United States and in any country foreign thereto, and to cooperate and assist in the prosecution of interference proceedings involving said inventions and in the adjudication or reexamination of said Letters Patent provided the expenses which may be incurred by me in lending such cooperation and assistance are paid by HKUST.

In witness whereof, we hereunto set our hands and seal:

Inventor's
Signature:

Nancy Ip
Nancy Yuk-yu Ip

Date:

Oct 9, 2003

Inventor's
Signature:

Yung-hou Wong
Yung-hou Wong

Date:

Oct 9, 2003

Inventor's
Signature:

David M. Miller-Martini
David M. Miller-Martini

Date:

Oct 9, 2003

BEST AVAILABLE COPY

Exhibit B

Perkins
Coie

LeeAnn Gorthey, Ph.D.
(650) 838-4403
gortl@perkinscoie.com

June 9, 2006
via email

101 Jefferson Drive
Menlo Park, CA 94025-1114
PHONE: 650.838.4300
FAX: 650.838.4350
www.perkinscoie.com

David Earp
Geron Corporation
230 Constitution Drive
Menlo Park, CA 94025

Re: U.S. National Phase Application No. 10/562,374
for **COMPOSITIONS AND METHODS FOR INCREASING TELOMERASE ACTIVITY**
Your Reference: 510/200 PCT
Our Reference: 38797-8004.US00

Dear David:

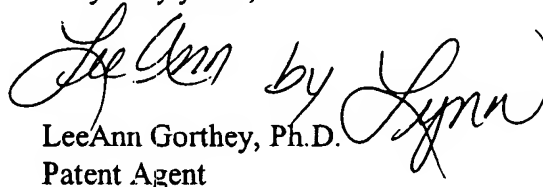
Enclosed for your information and records is a copy of a Notification of Missing Requirements which we received from the U.S. Patent and Trademark Office in the above-identified patent application. Also enclosed are a Declaration and Assignment document to be executed by the inventors, Calvin B. Harley, Allison C. Chin, Tsutomu Akama, Nancy Yuk-Yu Ip, Yung-hou Wong and David Miller-Martini.

Please have the inventors sign and date the declaration and assignment where indicated and return them to our offices as soon as possible. Also, please have an authorized representative of Geron Corporation sign and date the Power of Attorney and return it with the other executed documents.

A response to this Notification of Missing Requirements is due by July 8, 2006, however, time extensions are available, if required.

If you have any questions, please do not hesitate to contact us.

Very truly yours,


LeeAnn Gorthey, Ph.D.
Patent Agent

LAG/lbk
Encs.

cc: K. Zielen (via email with enclosures)

BY061530.048

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ANCHORAGE · BEIJING · BELLEVUE · BOISE · CHICAGO · DENVER · LOS ANGELES
MENLO PARK · OLYMPIA · PHOENIX · PORTLAND · SAN FRANCISCO · SEATTLE · WASHINGTON, D.C.

Perkins Coie LLP and Affiliates

June 15, 2006
By Courier

Exhibit C

GERON IP GROUP

JUN 16 2006

DOCKETED

geron

www.geron.com

Professor Tony R. Eastham
President/Chief Executive Officer
HONG KONG UNIVERSITY OF SCIENCE AND TECHNOLOGY
R AND D CORPORATION LIMITED
Clear Water Bay
Kowloon, Hong Kong

Re:	Application Serial No.	Title	Geron Docket No.	Date Filed
	10/563,533	FORMULATIONS CONTAINING ASTRAGALUS EXTRACTS AND USES THEREOF	500/002	December 23, 2005
	10/562,374	COMPOSITIONS AND METHODS FOR INCREASING TELOMERASE ACTIVITY	510/002	
	10/562,410	COMPOSITIONS AND METHODS FOR SKIN CONDITIONING	511/002	

geron corporation
230 Constitution Drive
Menlo Park, CA 94025
Tel: (650) 473-7700
Fax: (650) 473-7750

Dear Mr. Eastham:

We have received a Notification of Missing Requirements from the U.S. Patent & Trademark Office, which requires the filing of an executed Declaration by the inventors for each of the above-referenced U.S. National Stage patent applications. These applications were addressed in David Earp's letter to you of November 9, 2005.

I have provided you with a copy of each of the PCT applications as published, a copy of any amendments made while in the International Stage, and a copy of the Preliminary Amendment filed as they entered the U.S. National Stage.

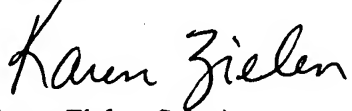
Enclosed for signature by inventors Nancy Yuk-yu Ip, Yung-hou Wong, and David M. Miller-Martini is an Inventor Declaration for each of the above-referenced applications. The inventors should sign and date each document on the appropriate lines after reading a copy of the applications as filed on December 23, 2005. The signatures need not be witnessed or notarized. The inventors should also check all personal data for accuracy. If there are any errors (e.g., spelling of the inventor's name), the inventor should make any necessary corrections AND INITIAL AND DATE THEM.

The due-date for response is **July 10, 2006**. Therefore, please expedite completion and return the Declarations to us before the actual due date.

Professor Tony R. Eastham
June 15, 2006
Page 2 of 2

Thank you for helping us comply with these formalities. If you have any questions about this letter or the enclosed documents, please call.

Sincerely,

A handwritten signature in cursive script that reads "Karen Zielen".

Karen Zielen (Mrs.)
Patent Secretary

Enclosures

geron

Gorthey, LeeAnn (Perkins Coie)

Exhibit D

From: Beechbum145@aol.com
Sent: Tuesday, July 11, 2006 9:19 AM
To: Gorthey, LeeAnn (Perkins Coie)
Cc: martinid@alltel.net
Subject: PCT Applications (Geron/HKUST)

Dear Ms. Gorthey,

I attempted to contact you yesterday at the Perkins Coie office in Menlo Park and received your voice mail that you have relocated.

I am relaying a message from Dr. Miller-Martini pertaining to the three PTC applications that he received from HKUST. At this time, Dr. Miller-Martini is out of town and has forwarded these applications to his attorney, Mr. David Pontzer of the Law Offices of Pontzer and Pontzer. He has indicated to his attorney several concerns he has regarding these applications and Mr. Pontzer is preparing a response.

Dr. Miller-Martini has requested that I contact you in the event you have not yet heard from Mr. Pontzer to indicate that the matter is being addressed. He has requested that you directly contact Mr. Pontzer at 814.773.3108 with any questions or pending deadlines.

In general, his three concerns pertain to an incorrect reference to his citizenship, current address, and order of inventors listed in the applications.

Regards,
Kathleen Geubelle, EO

8/30/2006

Gorthey, LeeAnn (Perkins Coie)

Exhibit E

From: Gorthey, LeeAnn (Perkins Coie)
Sent: Monday, August 14, 2006 9:59 AM
To: 'Beechbum145@aol.com'
Cc: martinid@alltel.net; Kennelly, Lynnea (Perkins Coie); 'dearp@geron.com'
Subject: RE: PCT Applications (Geron/HKUST)

Dear Ms. Geubelle,

Further to your email of July 11th, I left a message with Mr. Pontzer last Monday but have not received a reply. I will be going out of town shortly, returning the end of next week. I wanted to see if we could get this cleared up without too much further delay, since it does not sound like the issues are that complicated.

Your email indicated that Dr. Miller-Martini's concerns are "an incorrect reference to his citizenship, current address, and order of inventors listed in the applications". The first two would be no trouble at all to correct as long as we have the correct information. This could be forwarded to my secretary, Lynn Kennelly (lkennelly@perkinscoie.com) with a copy to me. (Alternatively, the inventor can simply make the necessary changes by hand, and date and initial them.)

The order of inventorship is a little less straightforward, since it is sometimes a touchy subject. Please note that the order of inventorship has *no* legal significance. That said, it can still have significance to the inventors. If you could give me some more specific idea of what the issues are here, I would appreciate it. (e.g. Does Dr. Miller-Martini wish to be listed first? If so, does he have a feeling as to whether the other inventors are likely to object to this?)

We're currently on a two month extension for two of the applications (if filed by September 8th) and a three month extension for the third (if filed by September 13th). The fees increase with time, and extensions longer than five months are not permitted. Since we will have to get fresh signatures for all the inventors if the order on the declaration is changed, we would like to get this moving if that is the case.

Thanks very much,

LeeAnn Gorthey

LeeAnn Gorthey, Ph.D.
Patent Agent
Perkins Coie LLP
(503) 727-2116 office
(503) 235-2128 home
(408) 636-3084 cell
Lgorthey@perkinscoie.com

-----Original Message-----

From: Beechbum145@aol.com [mailto:Beechbum145@aol.com]
Sent: Tuesday, July 11, 2006 9:19 AM
To: Gorthey, LeeAnn (Perkins Coie)
Cc: martinid@alltel.net
Subject: PCT Applications (Geron/HKUST)

Dear Ms. Gorthey,

I attempted to contact you yesterday at the Perkins Coie office in Menlo Park and received your voice

8/30/2006

From: David Miller-Martini [martinid@windstream.net]
Sent: Thursday, August 17, 2006 10:11 AM
To: Gorthey, LeeAnn (Perkins Coie)
Cc: Kennelly, Lynnea (Perkins Coie); dearp@geron.com; gwood@webblaw.com
Subject: Re: RE: PCT Applications (Geron/HKUST)

Dear Ms. Gorthey:

In response to your email regarding the issues pertaining to the three PCT applications, please be advised that there are a number of other outstanding issues complicating the execution of these documents.

To hopefully help expedite the execution of the three applications in due course; I would kindly request that your firm readies the applications with the following corrections:

Address correction: 409 Pine St., Ridgway, PA 15853
Citizenship correction: United States of America
Inventorship Correction: First position

Furthermore, execution of these documents will only occur 'subsequent' to your client and their joint venture partner having obtained an appropriate license to my rights and interests in these drug molecules/fractions/formulations.

I will further require evidence to these corrections on the three pending patent applications that have already been submitted to the USPTO for review and that are related to said PTC applications. Given that the provisional patent applications filed in June 2003 have all since been abandoned, I would also like to request copies of the "Combined Declaration and Power of Attorney" and "Assignment" documents (along with copies of the corresponding patent applications), which I executed for the new patent applications that were filed in December 2005.

Additionally, please be advised that I have retained new legal counsel in order to continue efforts to legally establish my ownership claims in the recently submitted patent applications related to "telomerase activators."

I extend my apology for the slow replies, or lack thereof, in responding to your past communications via my previous legal counsel. However, I can assure you that The Webb Law Firm will assist me in a more timely and professional manner in addressing any outstanding issues on the subject.

In this regard please redirect any further correspondence on this matter to:

Gwendolyn R. Wood, Ph.D.
The Webb Law Firm
700 Koppers Building
436 Seventh Avenue
Pittsburgh, PA 15219

Telephone: 412-471-8815
FAX: 412-471-4094

Kind regards,
David M. Miller-Martini, Ph.D., MBA

+++++

> From: "Gorthey, LeeAnn \ (Perkins Coie\)" <LGorthey@perkinscoie.com>
> Date: 2006/08/14 Mon PM 12:59:09 EDT
> To: <Beechbum145@aol.com>
> CC: <martinid@alltel.net>,
> "Kennelly, Lynnea \ (Perkins Coie\)" <LKennelly@perkinscoie.com>,

From: David Miller-Martini [martinid@windstream.net]
Sent: Monday, August 28, 2006 12:09 PM
To: Gorthey, LeeAnn (Perkins Coie)
Cc: Kennelly, Lynnea (Perkins Coie); dearp@geron.com; pontzerlaw@adelphia.net
Subject: Re: RE: PCT Applications (Geron/HKUST)

Dear Ms. Gorthey:

At this time, please be advised that The Law Offices of Pontzer & Pontzer will resume handling this case on my behalf until further notice. Also the Webb Law Firm as previously indicated has been retained for their Patent expertise.

Further to your email of August 14, 2006, please be informed that I'm currently seeking legal counsel on the matter from several sources and should it be in my best interest to sign the three PCT Application, and in so doing I do not forfeit my rights and interests in these inventions, I will be happy to execute the three applications with the indicated corrections.

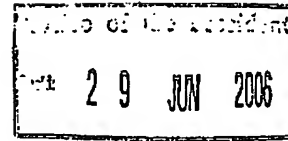
Mr. David Pontzer will be contacting your office in due course in response to your email pertaining to the three PCT applications.

Kind regards, David M. Miller-Martini

> From: "Gorthey, LeeAnn \ (Perkins Coie\)" <LGorthey@perkinscoie.com>
> Date: 2006/08/14 Mon PM 12:59:09 EDT
> To: <Beechbum145@aol.com>
> CC: <martinid@alltel.net>,
> "Kennelly, Lynnea \ (Perkins Coie\)" <LKennelly@perkinscoie.com>,
> <dearp@geron.com>
> Subject: RE: PCT Applications (Geron/HKUST)
>
>
> Dear Ms. Geubelle,
>
>
> Further to your email of July 11th, I left a message with Mr. Pontzer
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> The order of inventorship is a little less straightforward, since it is
> sometimes a touchy subject. Please note that the order of inventorship
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> to the inventors. If you could give me some more specific idea of what
> the issues are here, I would appreciate it. (e.g. Does Dr.
> Miller-Martini wish to be listed first? If so, does he have a feeling
> as to whether the other inventors are likely to object to this?)
>

June 16, 2006

Dr. John C. Chan, GBS, JP
Council Chairman
Hong Kong University of Science and Technology
Clearwater Bay Rd.
Kowloon, Hong Kong SAR China



Dear Dr. Chan:

Instead of my solicitor drafting and posting a more impersonal letter, I wanted to extend a professional courtesy to you by drafting this original letter myself. It is my hope that the letter will make clear my position and intentions with respect to my rights and interests in the "telomerase activators", which might be considered a misnomer given that their molecular target(s) are well upstream of telomerase. As you know, these small molecule compounds are currently being developed under a joint venture between the Biotechnology Research Corporation and Geron.

As you should also know, it was primarily through my efforts that the groundwork was laid for initiating the discovery program with Geron that focused on the screening of 50 TCMs for materials possessing biological activities that were capable of increasing telomerase activity in cultured keratinocytes. Moreover, I also played a key role in selecting and screening the materials, as well as identifying the active metabolite in *Astragalus membranaceus* (namely, astragaloside IV; formerly known as GRN-951) that possesses significant telomerase up-regulating potential. An aglycone of this compound (formerly GRN-665) is currently regarded as the lead candidate in the HIV/AIDS program. In this light, I am included as one of the inventors on several patent filings associated with these molecules and active fractions. Additionally, there were a number of other TCMs included in the original 50 herbal medicines that likewise possessed biological activities that resulted in the up-regulation of telomerase. I also screened several other semi-pure fractions and single entity compounds (the identities of which I will not disclose at this time) that were not included in the original group of 50 TCMs since they were known to simulate the ERK signaling pathway, and they too resulted in the substantial up-regulation of telomerase activity. With respect to the collection of "telomerase activator" materials as a whole, please note that I currently maintain certain rights and interests in their commercial development.

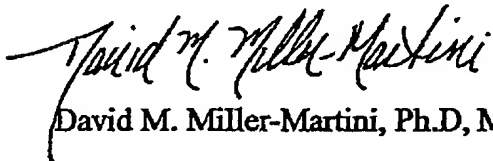
Although I had engaged in various conversations with a number of the Senior Administrators at HKUST regarding the transfer of my rights and interests to these materials under specified terms and conditions, they never came to fruition. Furthermore, I have not signed any agreements or contracts to the contrary. Review of my personnel file from November 1997 through June 2005, will show a series of employment contracts which designated my employment status as a "non-regular appointment." Further review of the terms and conditions of my employment will show that I was not then, or now,

being held to any terms or conditions of confidentiality, non-compete, or publication restrictions, nor is there any stipulation in these contracts regarding assignment of any IPR that I may be associated with to the University.

At this juncture, I wish to provide the University with the first right of refusal to my rights and interests in said IP. I will provide you 45 days from the date of this letter to indicate your interest in negotiating a license. Thereafter, I will make full disclosure of these materials in efforts to negotiate several non-executive licenses with a number of third party competitors interested in commercializing various aspects of these small molecules and crude/semi-crude fractions.

Please direct all correspondence pertaining to this matter to Mr. David Pontzer, Esq. at the Law Offices of Pontzer & Pontzer. His contact information is as follows: 220 Center Street, Ridgway, PA 15853; telephone 814-773-3108.

Sincerely,



David M. Miller-Martini, Ph.D, MBA

DMM-M/rgm

c.c. Mr. David Pontzer, Esq., The Law Offices of Pontzer & Pontzer
~~Professor Paul Ching-Wai Chan, President, HKUST~~
The Honourable Ronald Arculli, GBS, JP, Chairman, Board of Stewards, HKJC
Dr. Thomas Okarma, CEO and Director, Geron
Mr. Noel Patton, President, Asia Biotechnology Corporation